The opinion in support of the decision being entered today was ***not*** written for publication and is ***not*** binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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***Ex parte*** MATTHEW D. MOTTIER, MIKE M. ALBERT
and JOSHUA P. KIEM

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Appeal No. 1998-2727
Application 08/220,949

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ON BRIEF

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Before BARRETT, HECKER and DIXON, ***Administrative Patent Judges***.

HECKER, ***Administrative Patent Judge***.

This is a decision on appeal from the final rejection of claims 11, 12 and 18 through 21, all claims pending in this application.

The invention relates to a radio with silent and audible alerts for alerting a user that a call has been received. Silent alerts, such as a vibrating device, can be used where audible alerts would be objectionable (e.g.,

library or movie) or where the ambient noise level is so high that the audible alert would not be heard. On the other hand, a silent alert would not be effective (i.e., felt) when the radio is not carried by the user, such as when the radio is intercoupled with an external power supply or some other holder away from the user's body. A manual control can be provided to alternatively select between the audible alert and the silent alert for different situations. However, the user may forget that the silent alert had been selected and miss a call when the radio is placed in an accessory (e.g., external power supply). The invention can detect when the radio is placed in an accessory, etc., and upon such detection, automatically activate the audible alert, even if the silent alert had been manually selected.

Representative independent claim 11 is reproduced as follows:

11. A radio capable of being coupled to an accessory, the radio comprising:

a receiver for receiving a valid information signal;

a silent alert generator for indicating the reception of the valid information signal when the silent alert generator is enabled and activated;

an audible alert generator for indicating the reception of the valid information signal when the audible alert generator is enabled and activated; and

a processor for:

determining whether or not the radio is coupled to the accessory,

when the radio is determined not to be coupled to the accessory,

activating one of the silent alert generator and the audible alert generator during a first predetermined time period responsive to the reception of the valid information signal and responsive to the one of the silent alert and the audible alert generator being enabled, and

automatically activating the other one of the silent alert generator and the audible alert generator during a second predetermined time period exclusive of the first predetermined time period responsive to the reception of the valid information signal and responsive to the other one of the silent alert and the audible alert generator being enabled, and

when the radio is determined to be coupled to the accessory,

enabling the audible alert generator, when disabled, and

activating the audible alert generator during both the first and the second predetermined time periods responsive to the reception of the valid information signal and responsive to the audible alert generator being enabled.

The Examiner relies on the following references:

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| Matsumoto et al. (Matsumoto) | 4,879,759 | Nov. 7, 1989 |

Grothause 4,904,992 Feb. 27, 1990
Yamasaki 4,918,438 Apr. 17, 1990

Mottier et al. (Mottier patent) 5,696,497 Dec. 9, 1997
(Mottier application) S.N. 08/220,851[1]

Appellants' Admitted Prior Art (APA)

Claims 11, 12 and 18 through 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Yamasaki, APA, Matsumoto and Grothause.

Claims 11 and 18 through 20 stand rejected under the judicially created doctrine of double patenting over the Mottier patent.

Claims 11 and 18 through 20 stand provisionally rejected under the judicially created doctrine of double patenting over the Mottier application.

Claims 12 and 21 stand provisionally rejected under the judicially created doctrine of double patenting over the Mottier application and the Mottier patent, each in view of Matsumoto and APA.

Rather than reiterate the arguments of Appellants

[1] The examiner has not indicated the series number of the patent application in the double patenting rejection, but series "08" has an application by the same inventive entity.

and the Examiner, reference is made to the revised brief and answer for the respective details thereof.

***OPINION***

After a careful review of the evidence before us, we will not sustain the rejection of claims 11, 12 and 18 through 21

under 35 U.S.C. § 103 or the judicially created doctrine of double patenting.

At the outset, we note that Appellants present arguments regarding the formal content of the specification (brief-page 3). The Examiner is correct in that this issue relates to petitionable subject matter and is not before the Board of Patent Appeals and Interferences.

***DOUBLE PATENTING***

The Examiner contends that claims 11 and 18 through 20 are not patentable over the Mottier patent and the Mottier application, each taken separately, under the judicially created doctrine of double patenting. We agree with Appellants (brief-pages 5 and 6) that the claims before us are

patentably distinct from the claims of the applied references. The applied references do not claim the determination of whether the radio is coupled to an accessory nor the selection of the type of alert responsive to that determination.

The Examiner applied a two part test. We agree with the Examiner that the first part of the first test is met. That is, the subject matter of the claims before us is fully disclosed in the applied Mottier patent and application. However, we find that the claims of the applied patent and application do not provide **coverage** for the elements of the claims before us. There is simply no determination of whether or not the radio is coupled to an accessory in the applied patent or application claims, thus no **coverage** for the claims before us. Having failed the first test for this type of double patenting, we need not proceed to the second test.

Accordingly, we will not sustain the Examiner's judicially created double patenting rejection of claims 11 and 18 through 20.

With respect to the double patenting rejection of claims 12 and 21 (answer-page 10), we find nothing in the APA

to supply the missing accessory connection determination. We also do not agree with the Examiner that Matsumoto supplies the missing claim limitation, supra, in a manner consistent with 35 U.S.C. § 103, for the reasons enumerated infra in our discussion of the 35 U.S.C. § 103 rejection. Thus we will not sustain the Examiner's judicially created double patenting rejection of claims 12 and 21.

***35 U.S.C. § 103 REJECTION***

The Examiner has failed to set forth a ***prima facie*** case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the reasonable teachings or suggestions found in the prior art, or by a reasonable inference to the artisan contained in such teachings or suggestions. ***In re Sernaker***, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." ***Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.***, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995) (***citing W. L. Gore & Assocs., Inc. v.***

***Garlock, Inc.***, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), ***cert. denied***, 469 U.S. 851 (1984)).

With regard to claims 11, 12 and 18 through 21 (all pending claims), the Examiner cites Yamasaki for the claimed radio with silent and audible alerts and the processor. The Examiner further cites Matsumoto for a radio with detection of connection to an accessory before advanced functions can be performed, and cites APA for manual control to enable audio and silent alerts. Further, Grothause is cited for the particular claimed advanced functions. The Examiner states that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the detection aspects of Matsumoto with the radio of Yamasaki for alert activation because Matsumoto teaches this advantageous way of providing “advanced” alerts. Further, it would have been obvious to one of ordinary skill in the art at the time of the invention to use APA for a switch so that the user would have complete control to select the type of alert. Still further, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used the advanced

functions of Grothause as the advanced functions of the modified Yamasaki/Matsumoto/APA device. (Answer-pages 4-6.)

Appellants argue that none of the cited references independently teach changing the alert mode of the silent or audible alert in the radio responsive to detecting that the radio is coupled to an accessory. Further, although Matsumoto detects connection to a holder, Matsumoto merely adds functions **in the holder** such as a vibrator or a battery to the operation. Additionally, Grothause merely teaches alert selection **responsive to sound level**. (Brief-pages 4 and 5)

The Examiner responds that arguments against the applied references, individually, are not relevant to an obviousness rejection combining references. Further, Matsumoto teaches "The alert mode is changed **only** when the radio is connected to the [holder] see col. 2 lines 5-14." (Answer-page 11.)

We agree with the Examiner that arguments against the applied references, individually, are not relevant as to the combination. However, we do not agree that Matsumoto teaches the alert mode **is changed** when the radio is connected

to the holder in Matsumoto. The cited portion of Matsumoto teaches that an additional alert mode **is available** only when the radio is connected to the holder.

The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." ***In re Fritch***, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), ***citing In re Gordon***, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." ***Para-Ordnance Mfg. v. SGS Importers Int'l***, 73 F.3d at 1087, 37 USPQ2d at 1239, ***citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.***, 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13.

We find that combining the teachings of Matsumoto with Yamasaki would only provide **additional features** to Yamasaki when connection is detected. This does not teach or suggest selecting an **existing feature** in Yamasaki when

connection is detected as recited in Appellants' claims. Thus, Matsumoto adds features when connected to an accessory as opposed to changing the selection of existing features as claimed. Furthermore, APA and Grothause do not cure this deficiency in the stated rejection. Although Grothause changes the type of alert selected, this change is based upon ambient noise as opposed to detecting connection to an accessory. We see no teaching, suggestion, or rational as to how Grothause's change in alert selection, based on ambient noise, would make Appellants' claimed selection obvious, which is based on detection of an accessory connection.

Accordingly, we will not sustain the Examiner's 35 U.S.C. § 103 rejection of claims 11, 12 and 18 through 21.

We have not sustained the rejection of claims 11, 12 and 18 through 21 under 35 U.S.C. § 103 or the judicially created doctrine of double patenting. Accordingly, the Examiner's decision is reversed.

***REVERSED***

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| LEE E. BARRETT | ) | |
| Administrative Patent Judge | ) | |
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| | ) | BOARD OF PATENT |
| STUART N. HECKER | ) | |
| Administrative Patent Judge | ) | APPEALS AND |
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| | ) | |
| JOSEPH L. DIXON | ) | |
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